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JUL 13 2006

Remarks/Arguments

Claims 1-60 are pending in the application. Claims 61-63 are added. Claims 1-60 are rejected as anticipated by the newly cited Pricegrabber reference. Applicant respectfully submits that in view of the following remarks and arguments, all grounds of rejection are traversed and reconsideration is respectfully requested.

A prima facie case of anticipation has not been established because the Office Action does not identify how all elements of the claims can be found in the cited prior art, and in fact the cited prior art fails to teach or suggest various elements in each claim. The prior art must disclose each element of claimed invention. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). Further, full patentable weight must be given to each word in each claim, including words in the preamble or words that form functional language, because the wording helps distinguish the claimed invention over the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ("All words in a claim must be considered in judging the patentability of that claim against the prior art.")

The invention as claimed and disclosed addresses the problem inherent in the vast collection of existing electronic documents, such as web documents—they do not allow users to link to or retrieve information beyond what the document inherently provides or is structured to permit in its original form. The present invention expands the realm of contextually relevant information that a user may access by taking the original document and adding annotations that permit the retrieval of more information or data than was possible through the original document.

In contrast, the Pricegrabber.com system does not annotate a preexisting content document to expand the scope of contextually relevant information that a user may access.

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Instead, it relates to a conventional system that in response to a user query dynamically generates a new document with hyperlinks related to the user's query. The following remarks more specifically define the patentable differences between the claimed invention and the cited art.

There is no Prima Facie Anticipation of Claims 1-9 and 60 by Pricegrabber

Claim 1 recites, with emphasis added:

1. A method for generating annotation instructions in a system comprising a **content provider computer system, a central computer system, and a client computer system**, the method comprising:
 - in an electronic content document retrievable from a **content provider computer system storing content documents**, embedding code executable by a client computer to **invoke the central computer system to recognize key elements based on key elements contained in a key-element list**;
 - recognizing key elements in the document based on the key elements in the key-element list; and
 - generating annotation instructions for the client computer system to create one or more annotations for one or more key elements in the content document and sending the instructions to the client computer system.

No prima facie case has been made because Pricegrabber does not teach a "Central Computer System"

Claims 1-19, 48, and 60 recite a method or code executed in a three part system of (1) a client computer system (e.g., a consumer); (2) a content provider computer system (e.g., an online retailer); and (3) a central computer system (e.g., BizRate.com).

The Office Action in rejecting the aforementioned claims does not identify what is considered the claimed central computer system. It only identifies content pages of "provider" Pricegrabber.com. There is no mention whatsoever of the claimed central computer system.

Alternatively, if Pricegrabber is supposed to represent the central computer system, then the recited content provider system has not been identified. For either reason alone, the rejection must be withdrawn. Further, the recited interactions or functions of the computer systems have not been identified, as described in more detail below.

No prima facie case has been made because Pricegrabber does not teach the claimed recognition process

The Office Action essentially identifies a web document with searchable categories, a search engine, and results of a search with hyperlinks to results. All this is provided by and apparently performed on a comparison shopping site operated by Pricegrabber.com. The Office Action does not state how anything on that site becomes embedded with code that is executable by a client and thereby invokes a *central computer system* to undertake the claimed recognition process. While pricegrabber.com does teach creating a web page responsive to a user's query, the web page that is returned to the user is generated by and returned from the pricegrabber.com site i.e. *the content provider, not a central computer system*—in other words pricegrabber.com must be one or the other, it cannot be both).

Further, there is nothing on the page identified by the Office Action that would cause the client's system to then call a central computer to recognize key elements on that page. Notably, what the Office Action considers to be the recognition of the key elements is the user's query, but that, according to the Office Action, actually occurred before the client's system received a web page with alleged embedded code. Therefore, the Office Action's position is internally inconsistent and consequently does not establish that Pricegrabber discloses the claimed elements.

No prima facie case has been made because Pricegrabber does not teach modifying a stored content document

Further, the so-called web-document cited by the Office Action as corresponding to the claimed "content document" is not a stored content document as claimed: the web document of pricegrabber.com is generated on-the-fly based in response to a user's inputted keywords. The document is not part of a stored set of documents that can be embedded with code that is executable by a client to invoke a central computer system, as claimed.

For any one more of these reasons, the examiner has failed to establish a prima facie case of anticipation of claims 1-19 and 60. (Applicant reserves the right to specifically argue the missing elements in the dependent claims in this set.)

There is no Prima Facie Anticipation of Claims 20-59 by Pricegrabber

Claims 20-59 each recite various elements and arrangements of elements or steps that have not been identified in the Office Action and are missing from Pricegrabber. Therefore, there is no prima facie anticipation of these claims and all are patentably distinct over Pricegrabber for at least the same or similar to those given above, as well as additional reasons given below.

Independent Claim 20 recites, with emphasis added:

20. (previously amended) A method for sending annotation instructions in a system comprising at least two computer systems, the method comprising:

- on a first computer system, receiving over a packet-switched network a web page, the web page corresponding to a web page presented to the user of a second computer system;
- on the first computer system, recognizing in the web page one or more predetermined key elements based on a key-element list, the key element list comprising one or more words relating to one or more products; and
- sending annotation instructions from the first computer system to the second computer system for use in creating annotations on the web page presented on the second computer.

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As to claim 20-21, the Office Action makes no mention of the recited interplay of a first and second computer system. In particular there is no mention of a "first computer system, receiving ... a web page ... corresponding to a web page presented to the user of a second computer system (e.g., a consumer computer system). An example of this would be a web page viewable on a consumer computer system, such as represented in Fig. 12. The web page would be from a content provider, such as "Monthly Review of Tech Gadgets". The web page data may be sent to the first computer system, for example the comparison shopping system of BizRate.com. The first computer system then performs recognition functions to find keywords. It then sends instructions back to the second computer telling it how to annotate the page being viewed. The end result is that useful links and information are presented to a user that were not native to the page they had retrieved for viewing. There is nothing in Pricegrabber that teaches this set of claimed steps. Again, Pricegrabber merely generates pages from its own site and does nothing to retrieve web page data from a page that is being viewed by a consumer. Therefore, consequently cannot send annotation instructions back concerning any such page.

Independent Claim 22 recites, with emphasis added:

22. (original) A method comprising sending a key list from a remote computer system to a client computer system, the client computer having executable code for performing one or both of annotation and recognition of key elements on the key list, the key list comprising a set of key elements and corresponding identifiers; and the key list being adapted for the client computer to use in performing on an electronic document presented to a user of the computer system from a content provider computer system one or more of (i) recognizing key elements and (ii) annotating key elements.

Claims 22-26 relate to a method where instead of the recognition/annotation instructions being carried out on a computer system different from that of the user viewing the web page of a content provider, the functions are carried out on the user's computer system. However, the remote computer system (e.g., a central computer system, such as BizRate.com) enables the

user's computer system to recognize and annotate by sending it a key list of key elements and corresponding identifiers. The Office Action does not identify a client and remote computer that interact in this manner. For example, there is no teaching in Pricegrabber that a key list is sent, only web pages. Any web pages sent by Pricegrabber have preexisting hyperlinks that are executable by the client without any need for the client to analyze the page to recognize key elements based on any key list and/or to annotate the page if they are found.

Independent Claim 27 recites, with emphasis added:

27. (previously amended) A method in a system comprising at least a content provider computer system and a consumer computer system, the method comprising:

on a first computer system, receiving an electronic document with at least one predetermined key element;

from a second computer system, knowing the identity of the electronic document received on the first computer system, sending instructions to the first computer system for presenting to the user of the first computer system one or more hyperlinks related to a key element on the electronic document so the user may retrieve data or information related to the key element, the key element being contained in a key-element list, wherein the second computer system did not provide the electronic document received on the first computer system.

Claims 27-32 recite among other things: key elements and a key element list; sending of instructions from second computer based on the identity an electronic document on a first computer; and certain operations by different computer systems. The first computer system in this set of claims would typically be a consumer system. The electronic document on that system would typically be a web page from a content provider. The second computer system would typically be the central computer system that can know the identity of the page. The Office Action does not identify any teaching in Pricegrabber for one computer to know the identity of an electronic document on another computer that did not provide the document. The recited claim elements are not identified in the Office Action, and are patentably distinct over

Pricegrabber. Claim 27 has been amended to emphasize the distinction (amendments are indicated in underlining.)

Independent Claim 33 recites, with emphasis added:

33. (currently amended) A method in a system comprising at least two computer systems, the method comprising:

from a first computer system, providing a second computer system a set of predetermined key elements and corresponding identifiers for use in creating annotations for key elements on an electronic document;

receiving from the second computer system data associated with an annotation for a key element ("key element data") following selection of an annotation by a user of the second computer system, wherein the annotation was created by the second computer system using the key elements and corresponding identifiers provided by the first computer system;

retrieving or generating data or information responsive to the key element data received from the second computer system; and

sending the information to a computer system or output device associated with the user selecting the annotation.

Claims 33-44 recite among other things: key elements and corresponding identifiers, key element data, and interactions between different computer systems related to these items. The first computer in this set of claims would typically be the central computer system. The second computer system would typically be the consumer computer system. The recited claim elements are not identified in the Office Action, and are patentably distinct over Pricegrabber. Claim 33 has been amended to emphasize that the recited annotation is created by the second computer using key elements and identifiers provided by the first computer system.

Claims 45-59 recite elements the same as or similar to the claims discussed above, such as claims 1 and 22 and are patentably distinct for at least the same or similar reasons as those given above.

Applicant submits new claims 61-63. No new matter is added by these claims, and support is found throughout the specification and figures. See, for example, page 9, line 14-19.

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In view of the foregoing reasons that clearly and abundantly distinguish the claims over the cited art, Applicant has not comprehensively stated every basis for overcoming the rejections of the Office Action. Applicant, however, reserves the right to do so at a later time. Therefore, nothing herein should be deemed as a disclaimer of any rights, an acquiescence in any rejection or a waiver of any arguments that might have been raised but were not raised herein or otherwise in the prosecution of this application.

CONCLUSION

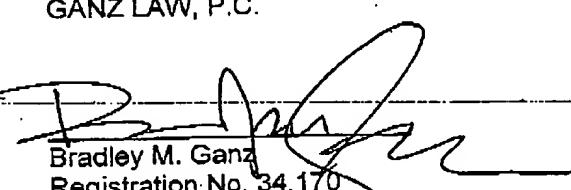
Applicant submits that in view of the foregoing remarks and/or amendments, the application is in condition for allowance, and favorable action is respectfully requested.

The Commissioner is hereby authorized to charge any fees, including extension fees, or to charge any additional fees or underpayments, or to credit any overpayments, to the Credit Card account referenced on the accompanying Credit Card Payment form (PTO-2038). As an alternative, in case the Credit Card cannot be processed, the Commissioner is hereby authorized to charge any fees, additional fees, or underpayments, or to credit any overpayments, to Deposit Account No. 50-1001.

Respectfully submitted,

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